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Atsushi Ogawa

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HOGAN & HARTSON L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

EXAMINER

YABUT, DIANE D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/539,662
Filing Date: June 14, 2005
Appellant(s): OGAWA ET AL.

Dariusz G. Adli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/26/2008 appealing from the Office action mailed 11/28/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. However, the new grounds of rejection is directed to the Teoh et al. reference wherein instead of the single closed loop being characterized by element **108** which is directly fixed to rounded head portion **107** in Figures 2C-2D, the single closed loop is now characterized by element **170** which is directly fixed to rounded head portion **182**.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0002732	TEOH ET AL.	01-2004
6,468,266	BASHIRI ET AL.	10-2002
6,013,084	KEN ET AL.	01-2000
2004/0034363	WILSON ET AL.	02/2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ken** (U.S. Patent No. **6,013,084**) in view of **Bashiri** (U.S. Patent No. **6,468,266**) and **Teoh** (U.S. Pub. No. **20040002732**).

Claims 1 and 8: Ken discloses an indwelling implant for embolization comprising a coil **191** that may be composed of a metal and a substantially semi-spherical rounded head portion at the distal end portion of the coil, wherein a loop **199** is provided inside said coil from said head portion of the coil toward the proximal end portion of the coil, and an axial extension controlling member **193** composed of at least one wire material and it is provided inside said coil by extending the member in the coil axial direction of said coil and fixing both ends thereof directly or indirectly to the proximal end portion in the inside of the coil after the member passed through said loop, wherein the loop is directly coupled to the axial extension controlling member (Figure 10, col. 5, lines 10-23 and col. 9, lines 29-51).

Ken discloses the claimed device except for the axial extension controlling member being composed of at least one wire material which is thinner than the metal wire material forming said loop, the loop being a single closed loop that is directly fixed to the rounded head portion.

Bashiri teaches a coil **120** with an axial extension controlling member **134** composed of at least one wire material which is thinner than the metal wire material

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forming said loop **138** (Figure 3). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a thinner material for the axial extension controlling member than the material forming said loop, as taught by Bashiri, to Ken in order to ensure a secure engagement with the loop and to prevent the coil from stretching when the coil is being repositioned (col. 5, line 58 to col. 6, line 18).

Teoh teaches a vaso-occlusive coil with a single closed loop **170** that is directly fixed to a rounded head portion **182**. It would have been obvious to one of ordinary skill in the art at the time of invention to provide a single closed loop directly fixed to a rounded portion, as taught by Teoh, to Ken since a closed loop configuration is identified as a coupling mechanism to other portions of the vaso-occlusive device (page 5, paragraph 52), which is well known in the art for secure linking or attachment of segments along a device.

Claims 2-3: Ken discloses the axial extension controlling member and loop being composed of the same metal material as the coil, such as platinum or a platinum alloy (col. 5, lines 10-23).

Claim 4: Ken discloses the axial extension controlling member being composed of a wire material with a diameter of 20 μ m or less (col. 5, lines 57-67, col. 6, lines 1-14 and col. 7, lines 1-7).

Claim 6: Ken, Bashiri, and Wilson disclose the claimed device except for the axial extension controlling member being further twisted after insertion through the loop.

Teoh teaches an axial extension controlling member being further twisted after insertion through the loop in order to keep the wire from collapsing on itself (Figures 2C-

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2D and page 6, paragraphs 55-56). It would have been obvious to one of ordinary skill in the art at the time of invention to provide the axial extension controlling member being further twisted, as taught by Teoh, to Ken, Bashiri, and Wilson in order to keep the wire from collapsing on itself, and therefore to maintain its function.

Claim 7: Ken discloses the coil being further formed to have a secondary shape (col. 9, lines 29-51).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ken** (U.S. Patent No. **6,013,084**) in view of **Bashiri** (U.S. Patent No. **6,468,266**) and **Teoh** (U.S. Pub. No. **20040002732**), as applied to Claim 4 above, and further in view of **Wilson** (U.S. Pub. No. **20040034363**).

Claim 5: Ken, Bashiri, and Teoh disclose the claimed device except for the axial extension controlling member being composed of a twisted wire obtained by twisting together a plurality of metal wire materials.

Wilson teaches an axial extension controlling member being composed of a twisted wire obtained by twisting together a plurality of metal wire materials (page 4, paragraph 30). It would have been obvious to one of ordinary skill in the art at the time of invention to provide the axial extension controlling member being composed of a twisted wire, as taught by Wilson, to Ken, Bashiri, and Teoh since it was known in the art that braided or winded wires provide strength and resistance to breakage or fracture.

(10) Response to Argument

Appellant argues that Ken, Bashiri, and Wilson do not disclose a hook that is directly fixed to a head, and the hook does not form a closed loop. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Appellant then generally argues that the closed loop **108** directly fixed to rounded head portion **107** in Teoh is a mischaracterization since the supposed “closed loop” **108** actually acts a stretch-resisting member, or as the “axial extension controlling member” as recited in the present claims. However, as maintained above, the argument is moot in view of the new grounds of rejection wherein the single closed loop is now characterized by element **170** which is directly fixed to rounded head portion **182**, as seen in Figures 2C-2D of Teoh.

Lastly, appellant's argument that the loop of Bashiri is provided on a proximal side rather than a distal end side relative to the axial extension controlling member is irrelevant since Bashiri is being relied upon for the teaching of the axial extension controlling member **134** being composed of at least one wire material which is thinner than the metal wire material forming said loop **138** (Figure 3). The appellant also argues that having the axial extension controlling member thinner than the loop is not explicitly described in Bashiri. However, the axial extension controlling member is described as being made of metallic wire or polymeric threads or fibers (col. 5, line 62 to col. 6, line 5), which is a material

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that appears to be thinner than the coil material of **120, 136, and 138** in Figure 3.

It would have been obvious to one of ordinary skill in the art at the time of invention to provide a thinner material for the axial extension controlling member than the material forming said loop, as taught by Bashiri, to Ken in order to ensure a secure engagement with the loop and to prevent the coil from stretching when the coil is being repositioned (col. 5, line 58 to col. 6, line 18).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

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(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Diane Yabut/

Examiner, Art Unit 3734

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Robert P Olszewski/

Director, Technology Center 3700

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Conferees:

Todd Manahan

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734

Xuan Thai

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715